

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 4, 2003. At the time of the Office Action, Claims 1-21 were pending in this patent application. The Examiner rejects Claims 1-21. Claims 1-2, 4-8, 10-14, and 16-21 have been amended to more clearly claim what the inventors believe to be the invention. Applicants have added new Claims 22-27. No new matter has been introduced by these amendments. Applicants do not admit that these amendments were made as a result of any cited art. Applicants respectfully request reconsideration and favorable action in this case.

Objections to the Drawings

The Examiner objects to the drawings for failing to comply with 37 C.F.R. § 1.84(p)(5) because the drawings include reference numerals 822 and 826, which are not mentioned in the description. Applicants have amended the Specification to include the omitted reference numerals. Accordingly, Applicants request that the objection to the drawings be withdrawn.

Objections to the Specification

The Examiner objects to the Specification. Specifically, the Examiner states that the spacing of the Specification makes reading and entry of amendments difficult. At the request of the Examiner, Applicants have attached a substitute Specification that is double spaced to this Response as Appendix A. Accordingly, Applicants request that the objection to the Specification be withdrawn.

Section 102 Rejections

The Examiner rejects Claims 1, 6, 7, 12, 13, and 18 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,046,742 issued to Chari ("*Chari*"). Because *Chari* does not teach each and every element in Applicants' claims, Applicants respectfully traverse these rejections.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. §

2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (*emphasis added*). Whether considered alone or in combination with any other cited references, *Chari* does not disclose, either expressly or inherently, each and every element of the claims.

For example, *Chari* does not disclose, teach, or suggest "identifying, without requiring physical inspection of the PCI slots, an unoccupied PCI slot, an unoccupied PCI slot comprising an identified PCI slot that is not coupled to an identified PCI device," as recited in Applicants' Claim 1. The Examiner has specifically identified Figures 2A, 2B, 29, 33, and 34 as disclosing the claimed features. Figures 2A and 2B, however, merely illustrate a MIB Tree, which includes the name of a server 136, the server type 202, and the major subsystems of the server 136. (Column 11, lines 24-27). The MIB tree is used to display "information regarding components in a computer network." (Column 4, lines 42-43). As such, *Chari* displays a window to the user that includes a MIB tree on the left side and icons representing major subsystems on the right side. (Column 11, lines 19-23 and 56-60). "The user may double-click on the icons on either the left part 602 or the right part 604 of the System Management Window 600 to access the subgroups and individual devices." (Column 11, lines 61-63). In response to a user double-clicking on an icon, "the MIB Manager Module 402 creates the form corresponding to the user's selection." (Column 11, line 67 through Column 12, lines 1). The forms are displayed to the user to display information about the components in the computer network.

Figures 29, 33, and 34 are examples of the forms that may be created. However, the specification of *Chari* contains no description of Figures 29, 33, and 34 other than that which is included in the Brief Description of the Drawings. Applicants assume that the Examiner is relying specifically on Figure 34 for disclosure of "identifying, without requiring physical inspection of the PCI slots, an unoccupied PCI slot, an unoccupied PCI slot comprising an identified PCI slot that is not coupled to an identified PCI device," as recited in Applicants' Claim 1. With regard to Figure 34, the specification merely provides that Figure 34 "illustrates one embodiment of a window for a single slot device." As illustrated, the left part of the screen displays the MIB Tree and includes eight slots in slot group number one. It is

assumed that all eight slots in slot group number one are occupied or were occupied at least at some time. When a slot from the left part of the screen is selected, information is displayed to the user about the particular slot on the right part of the screen. The information, which may include a slot group number, slot number, bus number, device number, and location, identifies the particular device that is or once was connected to the slot.

There is no teaching in *Chari*, however, of "identifying, without requiring physical inspection of the PCI slots, an unoccupied PCI slot, an unoccupied PCI slot comprising an identified PCI slot that is not coupled to an identified PCI device," as recited in Applicants' Claim 1. *Chari* does not disclose any way of even determining whether a device is currently connected. *Chari* merely discloses displaying information that identifies a particular device that is or once was connected to the slot. For at least these reasons, Applicants respectfully submit that *Chari* does not disclose, teach, or suggest "identifying, without requiring physical inspection of the PCI slots, an unoccupied PCI slot, an unoccupied PCI slot comprising an identified PCI slot that is not coupled to an identified PCI device," as recited in Applicants' Claim 1.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Applicants' Claim 1.

The Examiner also relies on *Chari* to reject independent Claims 7 and 13. Independent Claims 7 and 13, however, recite limitations that are similar to the features discussed above with regard to Claim 1. For example, Claim 7 recites "software encoded on the at least one computer readable medium and operable when executed by a processor to . . . identify, without requiring physical inspection of the PCI slots, an unoccupied PCI slot, an unoccupied PCI slot comprising an identified PCI slot that is not coupled to an identified PCI device." Claim 13 recites a processor coupled to the memory and operable to . . . identify, without requiring physical inspection of the PCI slots, an unoccupied PCI slot, an unoccupied PCI slot comprising an identified PCI slot that is not coupled to an identified PCI device." Thus, for reasons similar to those discussed above with regard to Claim 1, Applicants respectfully submit that *Chari* does not disclose, teach, or suggest each and every element as set forth in Applicants' Claims 7 and 13. *Chari* merely discloses displaying information that identifies a particular device that is or once was connected to a particular slot. As discussed above, *Chari* does not disclose any way of even determining whether a

device is currently connected. The recited features are absent from the method and system disclosed in *Chari*.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 7 and 13.

Dependent Claims 6, 12, and 18 that depend upon independent Claims 1, 7, and 13, respectively, are not anticipated by *Chari* because they include their respective independent claims and add additional elements that further distinguish the art. For example, Claim 6 recites "determining how many identified PCI slots are unoccupied." Claims 12 and 18 recite substantially similar limitations. As discussed above, *Chari* is limited to a system for displaying information that identifies a particular device that is or once was connected to a particular slot. As discussed above, *Chari* does not disclose any way of even determining whether a device is currently connected. Because *Chari* does not disclose determining whether a device is currently connected, *Chari* also cannot be said to disclose determining how many of the components include unoccupied PCI slots.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 6, 12, and 18.

Section 103 Rejections

The Examiner rejects Claims 2, 5, 8, 11, 14, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Chari* in view of U.S. Patent No. 6,397,268 issued to Cepulis ("*Cepulis*"). Because the *Chari-Cepulis* combination does not teach each and every element in Applicants' claims, Applicants respectfully traverse these rejections.

Claims 2 and 5, 8 and 11, and 14 and 17 depend upon independent Claims 1, 7, and 13, respectively, which Applicants have shown above to be allowable. Claims 2, 5, 8, 11, 14, and 17 are allowable at least because of their respective dependencies. Moreover, Claims 2, 5, 8, 11, 14, and 17 recite additional elements that further distinguish the art. For example, Claim 5 recites "identifying an unoccupied PCI slot comprises comparing a bus number and a device number of at least one of the identified PCI slots to a bus number and a device number of at least one of the identified PCI devices." Claims 11 and 17 recite similar features and operations.

In rejecting the recited features and operations, the Examiner relies on *Cepulis*. However, Applicants respectfully submit that *Cepulis* does not disclose the recited features and operations. Rather, *Cepulis* discloses a computer system that uses "physical slot information in conjunction with the PCI device function number to make sure that the PCI bus number is correct prior to executing the PCI device initialization." (Column 3, lines 60-64). "If there is a change in the bus number of a PCI device which has not been moved from its original physical card slot, then the present invention automatically updates the computer system device information during POST without having to run a new system configuration operation." (Column 3, line 60 through Column 4, line 1). Specifically, *Cepulis* discloses that "the PCI bus number, PCI device number and physical slot number are found in both the ESCD freeform information structure ECD__PCIBRDID and IRQ routing table." (Column 6, lines 8-10). During startup, a software routine "checks the contents of the ECD__PCIBRDID against the contents of the IRQ routing table." (Column 6, lines 26-28). "When the bus numbers do not mach for matching PCI device and slot numbers, the PCI device bus number stored in the IRQ routing table is used to replace the incorrect PCI device bus number stored in the NVRAM ESCD structure, ECD__PCIBRDID." (Column 6, lines 29-33). "In this way, the computer system ROM BIOS software finds the PCI devices which need to be configured for proper computer system startup, just as if the affected PCI device bus numbers had not been changed by the addition of a new PCI bus." (Column 6, lines 33-37). As such, *Cepulis* merely discloses comparing two stored versions of the PCI device numbers and bus numbers to determine whether a PCI device has a new bus number that needs to be updated. For at least these reasons, Applicants respectfully submit that *Cepulis* does not disclose, teach, or suggest "identifying an unoccupied PCI slot comprises comparing a bus number and a device number of at least one of the identified PCI slots to a bus number and a device number of at least one of the identified PCI devices," as recited in Claim 5. For similar reasons, Applicants respectfully submit that *Cepulis* also does not disclose, teach, or suggest the features and operations recited Claims 2, 8, 11, 14, and 17.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 2, 5, 8, 11, 14, and 17.

The Examiner rejects Claims 3, 9, and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Chari* and *Cepulis* in view of the "PCI IRQ Routing Table Specification" from Microsoft Corporation ("*Microsoft*"). Claims 3, 9, and 15 depend upon independent Claims 1, 7, and 13, respectively. Since Claims 3, 9, and 15 incorporate the limitations of their respective independent claims, which Applicants have shown above to be allowable, Applicants have not provided detailed arguments with respect to Claims 3, 9, and 15. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 3, 9, and 15.

The Examiner rejects Claims 4, 10, and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Chari* in view of U.S. Patent No. 6,269,417 issued to Mahalingam ("*Mahaligam*"). Claims 4, 10, and 16 depend upon independent Claims 1, 7, and 13, respectively. Since Claims 4, 10, and 16 incorporate the limitations of their respective independent claims, which Applicants have shown above to be allowable, Applicants have not provided detailed arguments with respect to Claims 4, 10, and 16. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 4, 10, and 16.

The Examiner rejects Claims 19, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Chari* in view of *Cepulis* and *Mahaligam*. Because the *Chari-Cepulis-Mahaligam* combination does not teach each and every element in Applicants' claims, Applicants respectfully traverse these rejections.

Claim 19 recites "comparing the bus number and the device number for each of the identified PCI slots to the bus number and the device number of at least one of the identified PCI devices; and determining if any of the identified PCI slots are unoccupied based on the comparison, an unoccupied PCI slot comprising an identified PCI slot that is not coupled to an identified PCI device." The Examiner specifically relies on *Chari* and *Cepulis* for disclosure of the recited features. Even when one considers the combined teachings of *Chari* and *Cepulis*, however, the recited features are not disclosed, taught, or suggested. As discussed above with regard to Claim 1, a user of the display system of *Chari* may sequentially select a particular slot associated with the server from the MIB tree on the left pane of the display window. Information about the particular slot is then displayed to the user on the right pane of the display window. Accordingly, *Chari* merely discloses a method

and system for displaying forms including information about various server components to a user. As discussed above, *Chari* does not disclose any way of even determining whether a device is currently connected. *Chari* also cannot be said to disclose *Chari* cannot be said to discloses either "comparing the bus number and the device number for each of the identified PCI slots to the bus number and the device number of at least one of the identified PCI devices" or "determining if any of the identified PCI slots are unoccupied based on the comparison."

The teachings of *Cepulis* do not make up for the deficiencies of *Chari*. As discussed above with regard to Claim 5, *Cepulis* merely discloses that the PCI bus number, PCI device number and physical slot number are stored in two separate locations. (Column 6, lines 8-10). During startup, the information from the two locations is compared to determine whether a PCI device has a new bus number that needs to be updated. (Column 6, lines 26-28). Thus, *Cepulis* merely discloses comparing one version of a PCI bus number, PCI device number, and physical slot number for a device associated with the server to another version of the PCI bus number, PCI device number, and physical slot number for the same device. Accordingly, *Cepulis* also cannot be said to disclose either "comparing the bus number and the device number for each of the identified PCI slots to the bus number and the device number of at least one of the identified PCI devices" or "determining if any of the identified PCI slots are unoccupied based on the comparison."

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 19.

The Examiner also relies on the *Chari-Cepulis-Mahalingam* combination to reject independent Claims 20 and 21. Independent Claims 20 and 21, however, recite limitations that are similar to the features discussed above with regard to Claim 19. For example, Claim 20 recites "software encoded on the at least one computer readable medium and operable . . . to . . . compare the bus number and the device number for each of the plurality of PCI slots to the bus number and the device number of the at least one PCI device; and determine if any of the identified PCI slots are unoccupied based on the comparison, an unoccupied PCI slot comprising an identified PCI slot that is not coupled to an identified PCI device." As another example, Claim 21 recites "a processor . . . operable to . . . compare the bus number and the

device number for each of the plurality of identified PCI slots to the bus number and the device number of the at least one PCI device; and determine if any of the identified PCI slots are unoccupied based on the comparison, an unoccupied PCI slot comprising an identified PCI slot that is not coupled to an identified PCI device." Thus, for reasons similar to those discussed above with regard to Claim 19, Applicants respectfully submit that the recited features are completely absent from the teachings of *Chari*, *Cepulis*, and *Mahalingam*.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 20 and 21.

New Claims

New Claims 22-23 and 24-25 have been added and depend on Claims 1 and 7, respectively, which Applicants have shown above to be allowable. Claims 22-25 are patentable at least because of this dependency and further because they recite additional features not disclosed, taught, or suggested in the prior art. Accordingly, Applicants respectfully request consideration and allowance of new Claims 22-25.

New independent Claims 26 and 27 have been added and are fully supported by the original Specification. No new matter has been added. For reasons similar to those discussed above with regard to Claims 1-21, Applicants respectfully submit that the references relied on by the Examiner do not teach each and every element in Applicants' Claims 26 and 27. For example, Claim 26 recites "generating a list of PCI slots associated with the computing device," "generating a list of one or more PCI devices coupled to the PCI bus," and "identifying, without requiring physical inspection of any PCI slots in the computing device, an unoccupied PCI slot by comparing the list of PCI slots associated with the computing device with the list of one or more PCI devices coupled to the PCI bus." As another example, Claim 27 recites "generating an identification table identifying a plurality of PCI slots associated with the computing device," "generating an enumeration table enumerating one or more PCI devices coupled to the PCI bus," and "identifying, without requiring physical inspection of any PCI slots in the computing device, an unoccupied PCI slot by comparing the identification table and the enumeration table." For reasons similar to those discussed above with regard to Claims 1-21, the recited features are completely absent from the

teachings of *Chari*, *Cepulis*, and *Mahalingam*. For at least these reasons, Applicants respectfully submit that new Claims 26 and 27 are allowable over the prior art.

Conclusions

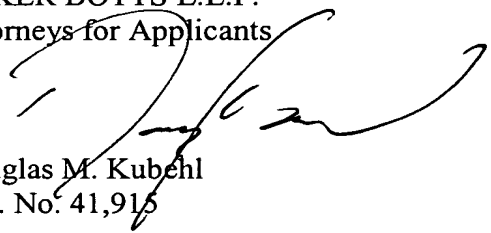
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants enclose a check in the amount of \$280.00 to cover the cost of additional claims. The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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